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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,784	07/06/2001	Kinya Washino	FNI-02503/03	2825
25006	7590	11/03/2006	EXAMINER	
GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021			LEE, MICHAEL	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/900,784

Applicant(s)

WASHINO ET AL.

Examiner

M. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 51-63 and 65-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-63, 65-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Upon considering applicant's appeal brief filed on 2/15/06, the Examiner determined that applicant's argument is persuasive, and in view of following rejections, the finality of the last office action is withdrawn.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 51-63, and 65-77 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. In the instant application, applicant merely claims a storage for storing the video program and source material and the supplemental information. There is no "useful, concrete and tangible result" produced.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 60 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 60, "the recording apparatus" lacks proper antecedent basis.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 51, 52, 55-59, and 61-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Langford et al. (5,206,929).

Regarding claim 51, Langford discloses an offline editing system showing one or more inputs and storage as claimed (see optical recorders 50 and edit decision list FDD). The edit decision list, which includes time codes, codes identifying the splices between edit on the list, and codes identifying the type of each splice (i.e., wipe dissolve, fade or simple cut) (see col. 7, 32-37) meets the correlated edit-time-code information and computer-readable scripting, casting or staging information as claimed.

Regarding claim 52, Langford shows an edit-decision-list.

Regarding claim 55, the edit-decision-list is user controllable (see col. 7, lines 38-43).

Regarding claim 56, see col. 7, line 37.

Regarding claim 57, see col. 7, lines 32-43.

Regarding claims 58 and 59, the video materials stored in the videotapes or disks represent camera shots from different angles. Each of these materials can be selected individually by using the time codes or scene points.

Regarding claim 61, the video signals and edit decision list are stored separately in Langford.

Regarding claim 62, the video signals are originally stored in tapes (see Figure 1).

Regarding claim 63, see col. 15, lines 52-56.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 60, 65, 66, and 69-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langford et al. (5,206,929).

Regarding claim 60, Langford does not specify that the recording apparatus forms part of a camcorder. The Examiner takes Official Notice that using a camcorder as recording device is well known in the art because a camcorder inherently includes some recording mechanism. Hence, it would have been obvious to one of ordinary skill

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in the art at the time of the invention was made to include a camcorder into Langford to perform the well-known functions as claimed.

Regarding claim 65, in addition of rejection to claim 51, Langford does not specify the step of recording the source material in digitally compressed form.

Recording video and audio signal in compressed digital format is notoriously well known in the art. Compressed digital video and audio signals enable video communication through narrow bandwidth channel and require less storage space. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to compress the video and audio signals in Langford so that the video and audio signals could be efficiently stored on a small recording medium.

Regarding claims 66, 69-77, see the corresponding rejections as given above.

### ***Response to Arguments***

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Lee whose telephone number 571-272-7349. The examiner can normally be reached on Monday through Thursday from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Omitzid L. Ometz, can be reached on 571-272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'M. Lee', with a large, stylized initial 'M' and a long horizontal flourish extending to the right.

M. Lee  
Primary Examiner  
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